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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,229	07/21/2004	Christopher K. Haas	57787US006	1499
32692	7590	10/12/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			VO, HAI	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

1771

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/502,229

Applicant(s)

HAAS ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 37-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0203</u> | 6) <input type="checkbox"/> Other: _____ |

Restriction/Election

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-36, drawn to a printable substrate.

Group II, claim(s) 37-56, drawn to a method of making a printable substrate.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is anticipated or obvious over Perez et al (US 6,420,024). As the recited structure does not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate.

During a telephone conversation with Kent S. Kokko on 10/05/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 37-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20 and 21 recite the limitation " said ink receptive layer" in line 1.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-6, 8-10, 14, 22-24, 26-29, 33 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 200200982. US 6,468,451 to Perez et al is relied on as an equivalent form of WO 200200982 for convenience. Perez discloses a high-melt strength, oriented polypropylene foam layer suitable as a receptive surface for printing (column 2, lines 55-60, column 14, lines 24-25). Likewise, the foam layer has an ink-receptive surface. The orientation is biaxial column 9, lines 23-25). The foam having a cell size of 50 microns or less is stretched up to 50 times total drawn ratio (column 10, lines 24-26). The substrate further comprises a release coating comprising a thermoplastic film layer and pigments which reads on Applicant's

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colored thermoplastic film (column 16, lines 10-15). The oriented foam is useful as a tape backing which is modified with a corona discharge to impart its release properties (column 15, lines 1-2, column 16, lines 20-25). The oriented foam is subjected to a mechanical fibrillation step to impart a fibrillated surface thereon (column 10, lines 60-65). The mechanical fibrillation uses cutting elements such as needles in contact with the film. Likewise, an aperture would be inherently formed through the film resulting from the mechanical fibrillation. The foam is thus embossed. Additionally, Perez discloses that fibrillating the foam using a mesh pattern support screen, the resulting schistose surface bears a pattern resembling the warp and weft of a textile (column 12, lines 20-25). Likewise, the foam is embossed. Perez does not specifically disclose a security document. However, it has been held that a recitation with respect to the manner in which a claimed printable substrate is intended to be employed does not differentiate the claimed printable substrate from a prior art fibrillated foam satisfying the claimed structural limitations. **Ex parte Masham**, 2 USPQ2d 1647 (1987). Accordingly, it is the examiner's position that Perez anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 11 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 200200982. Perez does not specifically disclose the bending stiffness of the substrate. However, it appears that the multilayer substrate of Perez meets all the structural limitations as required by the claims. The multilayer substrate comprises a high melt strength foam layer bonded to a thermoplastic film layer. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. Like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.
8. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 200200982. Perez teaches the use of additives in the foam material. Perez does not specifically disclose inorganic additives. The examiner takes Official Notice that it is common and well known to use inorganic additives in the foam material motivated by the desire to improve mechanical properties of the foam material.
9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 200200982 as applied to claim 10 above, further in view of Mody et al (US 5,605,729). Perez further discloses the article suitable as a loop fastener. Perez does not specifically disclose the article comprising two high melt strength oriented polymer foam layer and a thermoplastic film layer disposed therebetween. Mody, however, teaches a loop fastener comprising two foam backing 16 and a loop layer 14 disposed therebetween as shown in figure 1. Therefore, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to use the loop fastener having a layer construction as shown in the Mody reference because such is an intended use of the material and Mody provides necessary details to practice the invention of Perez.

10. Claims 15-21, 25, 30-32, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 200200982 as applied to claims 1, 10 and 29 above, further in view of Pedginski et al (US 5,807,632). Perez discloses the release coating being laminated to the fibrillated foam (column 15, lines 3-5). Perez discloses the release coating comprising fluorochemical constituents. Perez does not specifically disclose the release coating film being an ink-receptive layer. Pedginski, however, teaches an adhesive tape comprising an extrudable release coating film made from fluorochemicals grafted to ethylene/vinyl acetate copolymer (column 8, lines 56-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the fluorochemicals grafted to ethylene/vinyl acetate copolymer to form the extrudable release coating of the adhesive tape because such is an intended use of the material and Pedginski provides necessary details to practice the invention of Perez.

Since the release coating of Perez as modified by Pedginski is made of the same material as the ink receptive layer of the present invention, it is the examiner's position that the ink-receptive property would be inherently present. Like material has like property. This is in line with *In re Spada*.

Perez does not specifically disclose the release coating film being oriented. Pedginski, however, teaches an adhesive tape comprising an extrudable release coating film being oriented to increase the tensile strength of the film, resulting in a thinner release material layer, thereby giving improved performance and economy (abstract, column 10, lines 63-65 and figure 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an oriented release coating film as taught by Pedginski motivated by the desire to increase the tensile strength of the film, resulting in a thinner release material layer, thereby giving improved performance and economy.

Perez does not specifically disclose the release coating film being corona treated. Pedginski, however, teaches an adhesive tape comprising an extrudable release coating film being corona treated to enhance the adhesion (examples 11 and 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an corona treated release coating film as taught by Pedginski motivated by the desire to enhance the adhesion.

Perez discloses the adhesive tape comprising a layer construction as follow: a fibrillated foam backing, an adhesive layer and a release coating film (column 15, lines 48-51). Perez does not specifically disclose the release coating film being a laminate of the release coating and a thermoplastic film layer. Pedginski, however, teaches an adhesive tape comprising an extrudable release coating film comprising a release coating and a thermoplastic film layer to increase the strength of the release coating film (column 5, lines 30-65). Therefore, it would have been obvious

to one having ordinary skill in the art at the time the invention was made to use a thermoplastic film layer in combination with the release coating film motivated by the desire to increase the strength of the release coating film.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/502,210. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of of copending Application No. 10/502,210 fully encompass the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo

**HA VO
PRIMARY EXAMINER**